



15 DEC 2004

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. Box 1450
ALEXANDRIA, VA 22313-1450
www.uspto.gov

Israel Blum
Morgan & Finnegan, L.L.P.
345 Park Avenue
New York, New York 10154

In re Application of
OSTLUND et al.
Application No.: 10/500, 172
PCT No.: PCT/FI02/01037
Int. Filing Date: 18 December 2002
Priority Date: 28 December 2001
Attorney Docket No.: 6009-4711
For: A MOULD FOR CONTINUOUS
CASTING OR METAL STRIPS

DECISION ON
PAPERS UNDER 37 CFR 1.42

This decision is in response to the declarations filed 10 November 2004, which is being treated as a submission under 37 CFR 1.42. No petition fee is required.

BACKGROUND

On 18 December 2002, applicants filed international application PCT/FI02/01037, which claimed a priority date of 28 December 2001. A copy of the international application was communicated to the United States Patent and Trademark Office from the International Bureau on 10 July 2003. Pursuant to 37 CFR 1.495, the deadline for payment of the basic national fee was to expire on 28 June 2004.

On 24 June 2004, applicants filed a transmittal letter for entry into the national stage in the United States accompanied, inter alia, by: the basic national fee; a copy of the international application; an English translation of the international application; and a preliminary amendment.

On 27 September 2004, the United States Designated/Elected Office (DO/EO/US) mailed a Notification of Missing Requirements (Form PCT/DO/EO/905) requiring an oath or declaration in compliance with 37 CFR 1.497 and the surcharge fee required under 37 CFR 1.492(e). The notification set a two-month time limit in which to respond.

On 10 November 2004, applicants filed separate declarations executed by Sture Ostlund as inventor and Angela Vestman and Susanne Karlsson on behalf of deceased inventor, Bertil Vestman.

DISCUSSION

37 CFR 1.42 *When the Inventor is Dead*, states, in part:

In case of the death of the inventor, the legal representative (executor, administrator, etc.) of the deceased inventor may make the necessary oath or declaration, and apply for and obtain the patent.

Section 409.01(a) of the Manual of Patent Examining Procedure (MPEP) states that the application can also be executed by "all of the heirs" of the deceased inventor, where no legal representative has been appointed.

The declaration submitted on 10 November 2004 was executed by Angela Vestman and Susanne Karlsson on behalf of the deceased inventor, Bertil Vestman. However, the declaration does not state the relationship of Susanne Karlsson to the deceased inventor. Accordingly, the declaration fails to identify the proper relationship to the inventor under 37 CFR 1.497(b)(2).

In addition, it is noted that 37 CFR 1.497(b)(2) states the following:

(2) If the person making the oath or declaration or any supplemental oath or declaration is not the inventor (§§ 1.42, 1.43, or § 1.47) the oath or declaration shall state the relationship of the person to the inventor, and, upon information and belief, the facts which the inventor would have been required to state. If the person signing is the legal representative of a deceased inventor, the oath or declaration shall also state that the person is a legal representative and the citizenship, residence, and mailing address of the legal representative.

Pursuant to revised 37 CFR 1.497(b)(2), in addition to the citizenship and former residence and post office address of the deceased inventor referenced under 37 CFR 1.497(a)(3) and 37 CFR 1.63, the declaration must also provide residence, citizenship, and post office address for the legal representative. The declaration filed on 10 November 2004 provides this information with respect to Angela Vestman and Susanne Karlsson, but not the deceased inventor. Accordingly, the declaration is not in compliance with 37 CFR 1.497(a)(3) and 37 CFR 1.63.

Additionally, a review of the declarations filed on 10 November 2004 reveals that the declarations are not in an acceptable form. Applicants have provided a defective executed composite declaration. A composite declaration under 37 CFR 1.497(a)-(b) requires that the declaration must be complete and identify each inventor in each set of declarations provided. Specifically, the declarations filed on 10 November 2004 are defective pursuant to 37 CFR 1.497(a)(3) which requires that the declaration "identify each inventor and the residence and country of citizenship of each inventor." Section 201.03 of the Manual of Patent Examining Procedure states, in part,

While each inventor need not execute the same oath or declaration, each oath or declaration executed by an inventor must contain a complete listing of all inventors so as to clearly indicate what each inventor believes to be the appropriate inventive entity . . . For example, where the inventive entity is A and B, a declaration may not be executed only by A naming only A as the inventor and a different declaration may not be executed only by B naming only B as the inventor . . .

In this case, the declarations filed on 10 November 2004 only identify the individual(s) executing the declaration and does not identify the other inventors listed on the published international application. This is improper as each declaration gives the impression that there is only one inventor. Thus, applicants are required to file a newly executed declaration which complies with 37 CFR 1.497(a) and (b).

CONCLUSION

For the above reasons, the request for status under 37 CFR 1.42 is **REFUSED**.

Applicant is required to provide an oath/declaration in compliance with 37 CFR 1.497(a)-(b) within **TWO (2) MONTH** from the mail date of this Decision. Failure to respond will result in the abandonment of the application. Any reconsideration request should include a cover letter entitled "Renewed Submission Under 37 CFR 1.42" and must include an acceptable declaration under 37 CFR 1.497 which has been executed by either the legal representative of the deceased inventor or, if no legal representative has been appointed, all of the heirs of the deceased inventor.

Any further correspondence with respect to this matter should be addressed to: Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.



Anthony Smith
Attorney-Advisor
Office of PCT Legal Administration
Tel: (571) 272-3298
Fax: (571) 273-0459